

DEC 13 2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10007585-1Inventor(s): **Robert E. Haines**

Confirmation No.: 1660

Application No.: 09/976,830

Examiner: B. Ailes

Filing Date: **October 11, 2001**

Group Art Unit: 2142

Title: **Device Configuration Methods and Apparatus**

Mail Stop Appeals - Patents
Commissioner For Patents
PO Box 1480
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment
☐ New fee as calculated below
☐ No additional fee
☒ Other **Corrected Appeal Brief; Copy of Notice of Non-Compliant Brief**

- ☐ Petition to extend time to respond
☐ Supplemental Declaration

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1580		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Respectfully submitted,

Robert E. Haines

By: 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg No.: 39,833

Date: 12/13/06

Telephone: 509-824-4276

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Inventor(s): Robert E. Haines

Application No.: 09/076,630

Filing Date: October 11, 2001

PATENT APPLICATION

ATTORNEY DOCKET NO. 10007585-1

Confirmation No.: 1680

Examiner: B. Ailes

Group Art Unit: 2142

Title: Device Configuration Methods and Apparatus

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TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
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<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1590		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

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Respectfully submitted,

Robert E. Haines

By 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg No.: 39,833

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/976,630
Filing Date..... October 11, 2001
Inventor.....Robert E. Haines
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 2142
Examiner..... B. Alles
Attorney's Docket No. PDNO. 10007585-1
Confirmation No..... 1660
Title: Device Configuration Methods and Apparatus

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
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From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
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Appellant appeals from the final rejection, mailed November 16, 2005, of claims 1-36. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

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I. REAL PARTY IN INTEREST

The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012486, Frame 0165, and the full assignment to Hewlett-Packard Development Company, L.P. recorded starting at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. The Hewlett-Packard Development Company, L.P., is a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-36 are pending and stand finally rejected. Claims 37-39 were withdrawn from consideration by the Examiner without opportunity for response by Appellant. Appellant appeals the rejection of claims 1-36.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the final rejection mailed November 16, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

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Referring to independent claim 1, downloading data including a configuration plug-in and configuration data are depicted in exemplary embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in exemplary embodiments.

Referring to dependent claim 2, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to independent claim 8, exemplary embodiments of the downloading are described in exemplary embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in exemplary embodiments.

Referring to dependent claim 9, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to independent claim 15, exemplary memory is disclosed as reference 24 of Fig. 1 and processing circuitry is disclosed as reference 20 of Fig. 1 in one embodiment. Further, the downloading is described according to exemplary embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in exemplary embodiments.

Referring to dependent claim 16, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to independent claim 21, downloading of claim 21 is described according to exemplary embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in exemplary embodiments.

Referring to dependent claim 22, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

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Referring to dependent claims 28-30, downloading and setting of thresholds are described in one exemplary embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to claims 32-33 and 35-36, configuring of hard copy output engines according to exemplary embodiments are described at step S26 of Fig. 3 and S54 of Fig. 6.

VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 102 rejection of claims 1-14 and 21-33 over Hayward.
- B. The 102 rejection of claims 1-36 over Hayward.
- C. The 102 rejection of claims 1-36 over Hayward.
- D. The 102 rejection of claim 2 over Hayward.
- E. The 102 rejection of claims 9, 16, and 22 over Hayward.
- F. The 102 rejection of claim 28 over Hayward.
- G. The 102 rejection of claims 29 and 30 over Hayward.
- H. The 102 rejection of claim 30 over Hayward.
- I. The 102 rejection of claims 32 and 35 over Hayward.
- J. The 102 rejection of claims 33 and 36 over Hayward.

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VII. ARGUMENT

A. Positively-recited limitations of claims 1-14 and 21-33 are not disclosed by the prior art.

The above-recited claims recite downloading a configuration plug-in including user-specified information. In the Office Action at page 3, the Office identifies teachings in cols. 4 and 7 of Hayward as allegedly disclosing the claimed downloading. Appellant has failed to identify any teachings in cols. 4 and 7 of downloading a configuration plug-in as positively claimed. In fact, Appellant has electronically searched Hayward and failed to uncover any recitations to "plug" or "plug-in" as claimed. The limitations reciting a plug-in are not disclosed nor suggested by the prior art.

In addition, the teachings at col. 4, lines 12+ of Hayward disclose "a file of additional information" is directed to the peripheral after online registration. The teachings in col. 4 make clear that the file refers to *product support information* which may not be fairly interpreted to disclose or suggest the configuration plug-in including user-specified information. Further, there is no teaching in Hayward that the *diagnostic* module of col. 7, lines 50+ performs any *configuration operations* to be interpreted as a configuration plug-in or configuration data. Appellant submits that information regarding product support and performing diagnostics fail to disclose or suggest any teachings with respect to the claimed configuration plug-in or configuration data.

In addition, Appellant has been unable to locate any teachings in Hayward that the product support information or diagnostic module include any user-specified information. The teachings of cols. 4 and 7 of Hayward relied upon by the Office are void of disclosing downloading a configuration plug-in including user-specified information as positively-claimed.

On page 8 of the Action, the Office without identification of any reference teachings states that the HTML formatted page accessed over a network connection allegedly discloses Appellant's configuration plug-in. There is no evidence of record that an HTML formatted page discloses or suggests a plug-in. There is no evidence of record that an HTML page is a program that enhances or adds to the operation of a parent program corresponding to a configuration plug-in. Appellant respectfully submits the Office has failed to establish that the prior art

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discloses a configuration plug-in and the 102 rejection of the claims is improper for this reason.

The Office on page 8 of the Action also relies upon the teachings at col. 3, line 54 - col. 4, line 11 of Hayward as allegedly disclosing the limitations of downloading a configuration plug-in as claimed. However, the teachings in cols. 3-4 of Hayward disclose provision of HTML formatted pages and registration pages and the user may interact with the pages. There is no evidence of record that a page is a software program or plug-in as alleged by the Office on page 8 of the Action. The teachings of cols. 3-4 merely disclose a user interacting with HTML and registration pages which does not disclose downloading a configuration plug-in as claimed. Furthermore, Appellant respectfully submits there is no motivation to modify the teachings of Hayward to arrive at the limitations of downloading a configuration plug-in in view of the interaction with pages disclosed in Hayward. The teachings in cols. 3-4 fail to disclose the downloading of the plug-in limitations and Appellant respectfully submits the Office has failed to establish a proper 102 rejection.

Appellant also traverses any allegation that the downloading of the configuration plug-in of the claims is well known. On page 8 of the Action, the Office baldly alleges that web browsers use software plug-ins. However, the Office has cited no evidence in support of the assertion and Appellant traverses any assertion that the limitations of downloading a configuration plug-in in combination with other limitations of the claims are well known. Appellant traverses the reliance upon judicial notice and state that downloading a configuration plug-in including user-specified information has not been demonstrated to be well known. Further, Appellant has electronically searched and failed to uncover any teachings in Hayward of installation wizards or media players as apparently relied upon on page 8 of the Action.

MPEP 2144.03A (8th ed., rev. 3) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known. It is not appropriate for the Office to take official notice of facts without a reference where*

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the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually.

There is no evidence of record that the limitations of downloading a configuration plug-in are well known. There is no evidence of record that the specifically claimed combination of limitations reciting downloading the plug-in including user-specified information are well known in view of the generic teachings of Hayward merely disclosing user interaction with web pages. There is no evidence that the limitations of the plug-in being a configuration plug-in are well known. The mere usage of HTML pages in Hayward does not demonstrate that the limitations of downloading the configuration plug-in including user-specified information are well known.

Appellant respectfully submits that positively recited limitations of the claims are not disclosed by the prior art and the limitations absent from the prior art have not been demonstrated to be well known. Appellant respectfully requests allowance of the pending claims in the next Action for at least these compelling reasons.

B. Positively-recited limitations of claims 1-36 are not disclosed by the prior art.

The above-recited claims individually recite downloading configuration data including user-specified information as defined in claim 1. The Office relies upon the teachings of cols. 4 and 7 of Hayward at page 3 of the Action as allegedly teaching the above-recited limitations. However, Appellant respectfully submit the above-recited teachings are void of the claimed limitations. More specifically, the teachings at col. 4, lines 12+ of Hayward relied upon by the Office disclose "a file of additional information" is directed to the peripheral after online registration. The teachings in col. 4 make clear that the file refers to *product support information*

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which may not be fairly interpreted to disclose or suggest any teachings regarding configuration. Also, the file including product support information has not been demonstrated to include user-specified information.

Additionally, there is no teaching in Hayward that the *diagnostic* module of col. 7, lines 50+ relied upon by the Examiner performs any *configuration operations* to be interpreted as configuration data. Appellant submits that information regarding product support and performing diagnostics fail to disclose or suggest any teachings with respect to the claimed configuration data.

In addition, Appellant has been unable to locate any teachings in Hayward that the product support information (col. 4) or diagnostic module (col. 7) include any user-specified information. The teachings of cols. 4 and 7 of Hayward are void of disclosing downloading configuration data including user-specified information as positively-claimed.

At page 9 of the Action, the Office relies upon the teachings of col. 3, lines 54-64 of Hayward as allegedly disclosing the downloaded data including *user-specified information*. However, the teachings at col. 3 merely disclose a *product registration process*. The registration teachings of col. 3 are void of downloading configuration data including user-specified information. In addition, there is no evidence of record that the blank fields filled in by the user during the registration process result in user-specified information of configuration data. There is no evidence of record that the blank fields filled in by the user during the registration process result in user-specified information of the additional file (col. 4) or the diagnostic module (col. 7) relied upon by the Office as allegedly disclosing the configuration data.

At page 10 of the Action, Appellant disagrees with the Office's interpretation of "user-specified information." The Office has pointed to no teaching where Appellant has stated that user-specified information is to be limited to data which a user provides which is imperative for the configuration data to be retrieved appropriately. To the contrary, it is clear that the downloaded data including the user-specified information is defined in the claims as being used to configure the hard copy output engine and the claims are void of any limitation that the user-specified information is related to receipt of the configuration data. Accordingly, the teachings of col. 3, lines 54-64 of Hayward relied upon on page 10 of the

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Action allegedly teaching a user providing information in order to correctly receive configuration data is irrelevant to the claim limitations. The teachings in col. 3 relied upon on page 10 of the Action fail to disclose the claimed limitations of *downloading configuration data including user-specified information in combination with the configuring using the downloaded data*.

Appellants respectfully submit that positively recited limitations of the claims are not disclosed by the prior art and the limitations absent from the prior art have not been demonstrated to be well known. Appellants respectfully request allowance of the pending claims in the next Action for at least these compelling reasons.

C. Positively-recited limitations of claims 1-36 are not disclosed by the prior art.

The claims recite in varying forms *configuring the hard copy output engine using the downloaded data*. The teachings at col. 7, lines 48+ of Hayward relied upon by the Office on pages 3-4 of the Action fail to disclose the claimed *configuring*. More specifically, the teachings relied upon by the Office merely state that *the specific sub-modules test each part of the machine*. Performing diagnostics including testing of col. 7, lines 48+ may not be fairly interpreted to disclose or suggest the claimed *configuring*.

The Office at page 9 of the Action relies upon new teachings at col. 4, lines 13-19 and 42-45 of Hayward in view of Appellant's previous response. Col. 4, lines 13-19 of Hayward merely state that the file of additional information discussed above which provides the latest information may be stored on the computer and directed towards the precise configuration of the product. The provision of a file concerning information regarding a particular configuration of a product fails to disclose or suggest any configuring let alone *configuring a hard copy output engine using the downloaded data* as specifically claimed.

Referring to lines 42-45 of col. 4 of Hayward, the teachings relied upon by the Office refer to frequently asked questions (FAQ) or other support information, state that the information may become voluminous and that the information may be provided upon a web site as set forth in col. 4, lines 35-42. The teachings in lines 42-45 of col. 4 merely refer to providing a customer with information about the

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most recent configuration of the product. Providing a customer with FAQ information regarding their peripheral using an Internet website fails to disclose any configuration let alone the *configuring a hard copy output engine using downloaded data* as claimed.

Regarding page 10 of the Action, the Examiner again relies upon the teachings in col. 4, lines 13-19 and 42-45 of Hayward as allegedly teaching the claimed configuring. The Office states on page 10 of the Action at paragraph 32 that the teachings of col. 4 of Hayward disclose the vendor providing data needed by the user in order for the device to be configured properly. However, as set forth above, the file of additional information, the FAQ information, and the support information fail to teach or suggest any configuring of the hard copy output engine as positively claimed. The mere provision of the environment where the user is supplied with FAQ or support information fails to disclose or suggest the claimed configuring.

Appellant respectfully submits that positively recited limitations of the claims are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claims in the next Action for at least this reason.

D. Positively-recited limitations of claim 2 are not disclosed by the prior art.

The claim recites wherein the configuration plug-in and configuration data include data prepared by *determining user thresholds for consumables associated with the hard copy output engine*. The Office on page 4 of the Action relies upon teachings in col. 8, lines 38-44 of Hayward as allegedly disclosing the claimed preparation of the configuration plug-in and configuration data by determining user thresholds. However, the identified teachings merely state that a peripheral condition is used to indicate when a consumable has been exhausted or reached a predetermined threshold. The mere teachings of *usage of a threshold* are void of disclosing any teachings regarding *preparation of the configuration plug-in and configuration data which is downloaded let alone the claimed preparation by determining user thresholds* in combination with the downloading as positively claimed in claim 2.

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Furthermore, Appellant respectively asserts that the reliance upon inherency on page 11 of the Action in support of the rejection is misplaced. In particular, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP 2112 IV (8th ed., rev. 3). The claim 2 method of the configuration plug-in and configuration data prepared by determining user thresholds for consumables is not taught in the teachings of Hayward and the teachings have not been demonstrated to be inherent. Appellant respectfully submits Hayward fails to teach determination of user thresholds or that determination of user thresholds prepares the configuration plug-in and configuration data. Hayward is void of plug-in teachings or how such is prepared and alternatives exist for preparing configuration data apart from Appellant's specifically claimed preparing of configuration data by determining user thresholds. The existence of alternatives illustrates the inappropriateness of the reliance upon inherency in the rejection of claim 2 inasmuch as the limitations of claim 2 do not necessarily flow from the Hayward teachings. The rejection of claim 2 is improper at least in view of the above-recited authority and the Office's inappropriate reliance upon inherency.

Appellant respectfully submits that positively recited limitations of the claim are not disclosed by the prior art and the limitations absent from the prior art have not been demonstrated to be inherent. Appellant respectfully requests allowance of the pending claim in the next Action for at least these compelling reasons.

E. Positively-recited limitations of claims 9, 16, and 22 are not disclosed by the prior art.

The claims recite in varying forms *determining user thresholds for consumables associated with the hard copy output engine*. In addition, the claims 9, 16, and 22 respectively recite *code configured to cause a processor to determine the user thresholds*, *processing circuitry configured to employ a software module to determine the user thresholds*, and *instructions configured to cause the processor to determine the user thresholds*. The teachings of Hayward at col. 4, lines 12-19 and col. 8, lines 38-44 are void of disclosing how the thresholds for consumables of

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Hayward are defined let alone that they are user defined or defined as specifically recited in claims 9, 16, and 22. The bald generic teachings in Hayward regarding usage of thresholds fails to disclose any teachings regarding determining the user thresholds let alone the specific limitations recited in claims 9, 16 and 22.

Appellant respectfully submits that positively recited limitations of the claims are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claims in the next Action for at least these compelling reasons.

F. Positively-recited limitations of claim 28 are not disclosed by the prior art.

Claim 28 recites the downloading comprises downloading a value and the configuring comprises setting a threshold for a consumable associated with the hard copy output engine using the value. The Office on page 5 of the Action relies upon col. 4, lines 12-19 and col. 8, lines 38-44 of Hayward in support of the 102 rejection. Appellant respectfully submits that the teachings relied upon by the Office fail to disclose the limitations of the claim and the 102 rejection is improper.

More specifically, the teachings at col. 4 of Hayward merely state that a file of additional information is provided and the latest information may be stored in computer 30 and the information is directed to the precise configuration and date of the registered product. Appellant has failed to uncover any mention in col. 4, lines 12-19 of downloading a value or setting a threshold let alone the claimed setting the threshold for a consumable associated with the hard copy output engine using the value as claimed.

Furthermore, the Office relies upon the teachings of col. 8, lines 38-44 of Hayward. The teachings in col. 8 merely relate to how a threshold is used and fails to disclose downloading a value or setting a threshold for a consumable using the value as specifically claimed.

Appellant respectfully submits that positively recited limitations of the claim are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claim in the next Action for at least these compelling reasons.

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G. Positively-recited limitations of claims 29 and 30 are not disclosed by the prior art.

Referring to claim 29, the method recites *downloading a threshold for replenishment of a consumable*. The Office at page 6 of the Action relies upon col. 4, lines 12-19 and col. 8, lines 38-44 of Hayward in support of the 102 rejection. The teachings in col. 4 fail to mention a threshold for replenishment of a consumable let alone the specifically claimed downloading the threshold. Furthermore, col. 8, lines 38-44 of Hayward refer to usage of a peripheral condition to indicate when a consumable has been exhausted or a consumable has reached a predetermined threshold and Appellant has failed to uncover any teaching of the downloading the threshold for replenishment of the consumable.

Appellant respectfully submits that positively recited limitations of the claims are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claims in the next Action for at least these compelling reasons.

H. Positively-recited limitations of claim 30 are not disclosed by the prior art.

Claim 30 recites *the configuring comprises setting the threshold of the hard copy output engine for replenishment of a consumable associated with the hard copy output engine*. On page 6 of the Action, the Office relies upon the teachings of col. 4 and col. 8 of Hayward. The teachings in col. 4 are void of threshold teachings and col. 8 merely disclose usage of the thresholds. The Hayward teachings are void of the claimed configuring comprising setting the threshold.

Referring again to page 3 of the Action, the Office relies upon the teachings of col. 7, lines 48-60 of Hayward as allegedly disclosing the claimed configuring. The teachings of col. 7 of Hayward recite execution of different self *diagnostic routines* which may *test parts of the machine*. The Office provides no explanation as to how testing parts of a machine of col. 7 of Hayward are to be considered to disclose the specifically claimed *configuring comprising setting the threshold of the hard copy output engine for replenishment of the consumable associated with the hard copy output engine*.

The Office at page 9 of the Action relies upon teachings at col. 4, lines 13-19 and 42-45 of Hayward as allegedly teaching the configuring. Col. 4, lines 13-19

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of Hayward merely state that the file of additional information discussed above provides the latest information and may be stored on the computer and directed towards the precise configuration of the product. The provision of a file concerning information regarding a particular configuration of a product fails to disclose or suggest any configuring let alone configuring comprising setting the threshold of the hard copy output engine for replenishment of a consumable associated with the hard copy output engine as specifically claimed. The teachings in col. 4, lines 42-45 are void of the claimed configuring comprising setting the threshold.

Appellant respectfully submits that positively recited limitations of the claim are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claim in the next Action for at least these compelling reasons.

I. Positively-recited limitations of claims 32 and 35 are not disclosed by the prior art.

Claims 32 and 35 positively claim that the configuring comprises altering the hard copy output engine. The Office on page 6 of the Action relies upon the teachings of col. 4, lines 12-19 as allegedly disclosing the claimed altering. The Office has provided no explanation as to how the teachings of col. 4 are to be considered to disclose or suggest the claimed altering. The mere downloading of a file from a server fails to disclose the claimed altering of the hard copy output engine as specifically claimed. In addition, it is positively disclosed in the teachings at col. 4 relied upon by the Office that the file which is downloaded is stored in computer 30 which fails to teach any altering of the hard copy output engine as specifically claimed.

Appellant respectfully submits that positively recited limitations of the claims are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claims in the next Action for at least these compelling reasons.

J. Positively-recited limitations of claims 33 and 36 are not disclosed by the prior art.

Claims 33 and 36 positively claim that the configuring comprises altering an operation of the hard copy output engine with respect to the formation of images upon paper. The Office on page 6 of the Action relies upon the teachings of col. 4,

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lines 12-19 as allegedly disclosing the claimed altering. The Office has provided no explanation as to how the teachings of col. 4 are to be considered to disclose or suggest the claimed altering of the operation of the hard copy output engine with respect to formation of hard images upon paper as specifically claimed. The mere downloading of a file from a server as described in col. 4 fails to disclose the claimed altering of the hard copy output engine as specifically claimed. Furthermore, it is positively disclosed in the teachings at col. 4 relied upon by the Office that the file is stored *in computer 30* which fails to teach any *altering of the hard copy output engine* as specifically claimed.

With respect to the reliance upon inherency on page 6 of the Action, the Office has not demonstrated that configuring of the hard copy output engine comprising altering the operation of the hard copy output engine with respect to the formation of hard images upon paper as claimed necessarily flows from the teachings of Hayward as in necessary for proper reliance upon inherency in view of the authority recited previously. Appellant respectfully submits the limitations are not inherent.


Appellant respectfully submits that positively recited limitations of the claims are not disclosed by the prior art. Appellant respectfully requests allowance of the pending claims in the next Action for at least these compelling reasons.

K. Conclusion

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date: 12/12/06

Attorney: 
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VIII. CLAIMS APPENDIX

1 1. [Original] A method of configuring a hard copy output engine
2 comprising:
3 downloading data including a configuration plug-in and configuration data
4 each including user-specified information; and
5 configuring the hard copy output engine using the downloaded data.

1 2. [Original] The method of claim 1, wherein the configuration plug-in
2 and configuration data include data prepared by:
3 determining a make and model for the hard copy output engine; and
4 determining user thresholds for consumables associated with the hard
5 copy output engine.

1 3. [Original] The method of claim 1, wherein downloading includes:
2 sending an electronic message via the Internet to a website for a vendor
3 associated with the hard copy output engine; and
4 receiving an electronic message via the Internet in response to sending.

1 4. [Original] The method of claim 1, wherein downloading includes:
2 sending an electronic message via the Internet to a vendor associated
3 with the hard copy output engine; and
4 receiving an electronic message via the Internet in response to sending,
5 wherein sending and receiving include transmission across a firewall.

1 5. [Original] The method of claim 1, wherein configuring includes
2 setting a threshold for an element chosen from a group consisting of:
3 pigmentation material, marking material, number of hours of operation and
4 number of sheets of print media consumed.

1 6. [Original] The method of claim 1, wherein the hard copy output
2 engine is chosen from a group consisting of: facsimile machines, photocopiers
3 and printers.

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1 7. [Original] The method of claim 1, wherein the configuration plug-in
2 and configuration data include data prepared by:
3 determining a make and model for the hard copy output engine;
4 determining a serial number for the hard copy output engine; and
5 determining user thresholds for consumables associated with the hard
6 copy output engine.

1 8. [Original] An article of manufacture comprising a computer usable
2 medium having computer readable code embodied therein that is configured to
3 cause a processor to:
4 download data including a configuration plug-in and configuration data
5 each including user-specified information; and
6 configure a hard copy output engine using the downloaded data.

1 9. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to:
5 determine a make and model for the hard copy output engine; and
6 determine user thresholds for consumables associated with the hard copy
7 output engine.

1 10. [Previously Presented] The article of manufacture of claim 8,
2 wherein the computer readable code configured to cause the processor to
3 download data includes computer readable code that when executed causes the
4 processor to:
5 send a first electronic message across a firewall via the Internet to a
6 website for a vendor associated with the hard copy output engine; and
7 receive a second electronic message across the firewall via the Internet in
8 response to the first electronic message.

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1 11. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to download data
3 includes computer readable code configured to cause the processor to:
4 send a first electronic message across a firewall via the Internet to a
5 website for a vendor associated with the hard copy output engine; and
6 receive a second electronic message across a firewall via the Internet in
7 response to the first electronic message.

1 12. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to configure the hard copy output engine using the downloaded data
5 to set a threshold for an element chosen from a group consisting of:
6 pigmentation material, marking material, number of hours of operation and
7 number of sheets of print media consumed.

1 13. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to configure a hard copy output engine chosen from a group
5 consisting of: facsimile machines, photocopiers and printers.

1 14. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to:
5 determine a make and model for the hard copy output engine;
6 determine a serial number for the hard copy output engine; and
7 determine user thresholds for consumables associated with the hard copy
8 output engine.

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1 15. [Previously Presented] A computer implemented control system for
2 a hard copy output engine, the system comprising:
3 memory configured to store a software module; and
4 processing circuitry configured to employ the software module to:
5 download data including configuration data including user-specified
6 information; and
7 configure a hard copy output engine using the downloaded data.

1 16. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module
3 further comprises processing circuitry configured to employ the software module
4 to:
5 determine a make and model for the hard copy output engine; and
6 determine user thresholds for consumables associated with the hard copy
7 output engine.

1 17. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module to
3 configure includes processing circuitry configured to employ the software
4 module to configure the hard copy output engine using the downloaded data to
5 set a threshold for an element chosen from a group consisting of: pigmentation
6 material, marking material, number of hours of operation and number of sheets
7 of print media consumed.

1 18. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module
3 further includes processing circuitry configured to employ the software module
4 to:
5 send a first electronic message across a firewall via the Internet to a
6 vendor associated with the hard copy output engine; and
7 receive a second electronic message across the firewall via the Internet in
8 response to the first electronic message.

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1 19. [Original] The computer implemented control system of claim 15,
2 wherein the hard copy output engine is chosen from a group consisting of:
3 facsimile machines, photocopiers and printers.

1 20. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module
3 further comprises processing circuitry configured to employ the software module
4 to:
5 determine a make and model for the hard copy output engine;
6 determine a serial number for the hard copy output engine; and
7 determine user thresholds for consumables associated with the hard copy
8 output engine.

1 21. [Original] A computer instruction signal embodied in a carrier wave
2 carrying instructions that when executed by a processor cause the processor to:
3 download data including a configuration plug-in and configuration data
4 each including user-specified information; and
5 configure a hard copy output engine using the downloaded data.

1 22. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to:
6 determine a make and model for the hard copy output engine; and
7 determine user thresholds for consumables associated with the hard copy
8 output engine.

1 23. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to download data includes a computer instruction
4 signal carrying instructions that cause the processor to:

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5 send a first electronic message across a firewall via the Internet to a
6 website for a vendor associated with the hard copy output engine; and
7 receive a second electronic message across the firewall via the Internet in
8 response to the first electronic message.

1 24. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to download data includes a computer instruction
4 signal carrying instructions that when executed cause the processor to:
5 send a first electronic message across a firewall via the Internet to a
6 website for a vendor associated with the hard copy output engine; and
7 receive a second electronic message across a firewall via the Internet in
8 response to the first electronic message.

1 25. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to configure the hard copy output engine using the downloaded data
6 to set a threshold for an element chosen from a group consisting of:
7 pigmentation material, marking material, number of hours of operation and
8 number of sheets of print media consumed.

1 26. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to configure a hard copy output engine chosen from a group
6 consisting of: facsimile machines, photocopiers and printers.

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1 27. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to:

6 determine a make and model for the hard copy output engine;
7 determine a serial number for the hard copy output engine; and
8 determine user thresholds for consumables associated with the hard copy
9 output engine.

1 28. [Previously Presented] The method of claim 1, wherein the
2 downloading comprising downloading a value, and the configuring comprises
3 setting a threshold for a consumable associated with the hard copy output
4 engine using the value.

1 29. [Previously Presented] The method of claim 1, wherein the
2 downloading comprising downloading a threshold for replenishment of a
3 consumable associated with the hard copy output engine.

1 30. [Previously Presented] The method of claim 29, wherein the
2 configuring comprises setting the threshold of the hard copy output engine.

1 31. [Previously Presented] The method of claim 1, further comprising:
2 providing the user-specified information from a user; and
3 generating at least one of the configuration plug-in and configuration data
4 using the user-specified information before the downloading.

1 32. [Previously Presented] The method of claim 1, wherein the
2 configuring comprises altering the hard copy output engine.

1 33. [Previously Presented] The method of claim 1, wherein the
2 configuring comprises altering an operation of the hard copy output engine with
3 respect to formation of hard images upon paper.

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1 34. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry is configured to employ the
3 software module to set a threshold for replenishment of a consumable
4 associated with the hard copy output engine to configure the hard copy output
5 engine.

1 35. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry is configured to employ the
3 software module to configure the hard copy output engine comprising altering
4 the hard copy output engine.

1 36. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry is configured to employ the
3 software module to configure the hard copy output engine comprising altering an
4 operation of the hard copy output engine with respect to formation of hard
5 images upon paper.

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IX. EVIDENCE APPENDIX

Appellants submit no evidence with this appellate brief.

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X. RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related proceedings.

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Please find below and/or attached an Office communication concerning this application or proceeding.

DEC 13 2006

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/978,830 ✓	Applicant(s) HAINES, ROBERT E.	
	Examiner Benjamin A. Altes	Art Unit 2142	


-The MAILING DATE of this communication appears on the cover sheet with the correspondence address-

The Appeal Brief filed on 10 August 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within ONE MONTH or THIRTY DAYS from the mailing date of this Notification, whichever is longer. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

Under 37 CFR 41.37(c)(1)(viii) the Claims appendix is to only contain a copy of the claims involved in the appeal. In the instant case, claims 1-36 are pending and stand finally rejected. The Appellant is appealing the rejection of claims 1-36. The current claims appendix filed 10 August 2006 includes claims 1-36. Claims 37-39 stand withdrawn from consideration and are not involved in the appeal. Therefore, the current claims appendix is not deemed compliant in view of 37 CFR 41.37(c)(1)(viii) because the text of withdrawn claims is present. The text of the withdrawn claims should be removed in order to satisfy 37 CFR 41.37(c)(1)(viii).


 BEATRIZ PRIETO
 PRIMARY EXAMINER

Continuation Sheet (PTOL-462)

Application No.